



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,563	12/19/2001	Kenneth W. Aull	15-0256	1021

7590 04/10/2006

CHRISTOPHER P. HARRIS  
TAROLLI, SUNDHEIM, COVELL & TUMMINO LLP  
526 SUPERIOR AVENUE  
SUITE 1111  
CLEVELAND, OH 44114-1400

EXAMINER

BROWN, CHRISTOPHER J

ART UNIT PAPER NUMBER

2134

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

### Period for Reply

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-19 and 21-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-19, 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, filed , 12/29/05 with respect to objections and USC 112 rejections have been fully considered and are persuasive.

The USC 112 rejection of claims 5, and 20 have been withdrawn.

The Objection to claims 6, and 18 due to use of a trade name has been withdrawn.

Applicant's arguments filed 12/29/05 have been fully considered but they are not persuasive.

The applicant has amended claim 1 to incorporate "at the secure facility" for where the installation of a token system takes place. The applicant argues that the USC 102 rejection of Gien US 2002/0112156 *does* teach installation and personalization of a token at a secure facility, but does not "receive" a token to be personalized [0007]. The applicant argues that Gien, instead teaches both manufacturing and personalization at the same secure facility, and thus does not receive a token.

The examiner disagrees. While the token may be manufactured at the same location that personalization, or installation takes place, the examiner argues that the installation still "receives" the token, even if it is receiving it out of manufacturing systems. It is clear

Art Unit: 2134

that the secure facility receive tokens, otherwise how could installation of keys and personalization take place?

As per claim 2, the applicant argues that Gien does not disclose wiping the contents of a token, and instead teaches that it must be impossible to erase the token.

This is incorrect. The Examiner points to [0071] where Gien states “it must not be possible to erase the card and start personalization again, unless all private key material from a first personalization can be completely erased...” Thus Gien teaches complete erasure to protect the individuals that had private keys on the token from a first personalization.

Claim 15, although not amended, is argued by the applicant to incorporate the same “receiving” limitations as claim 1. The applicant argues that the USC 102 rejection of Gien US 2002/0112156 *does* teach installation and personalization of a token at a secure facility, but does not “receive” a token to be personalized [0007]. The applicant argues that Gien, instead teaches both manufacturing and personalization at the same secure facility, and thus does not receive a token.

The examiner disagrees. While the token may be manufactured at the same location that personalization, or installation takes place, the examiner argues that the installation still “receives” the token, even if it is receiving it out of manufacturing systems. It is clear that the secure facility receive tokens, otherwise how could installation of keys and personalization take place?

Art Unit: 2134

Applicants arguments for claims 3-6, 6-14, 16-19, and 21-24 all stem from the argument that claims 1, and 15 are allowable over the prior art, since the examiner argues that claims 1, and 15 are rejected, all dependent claims are also rejected.

The examiner has included the previous office action for the applicants convenience:

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 3, 5, 9-13, 15-17, 19 21, 23, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Gien US 2002/0112156.

As per claim 1, 5, 15, 16, 23, 24 Gien teaches that a hardware token is manufactured in a secure environment [0007], Gien teaches installing an operating system on a token, [0041]. Gien teaches creating a unique key encipherment certificate that comprises a public key for the token, [0190]. Gien teaches writing the unique key certificate onto the token, [0191]. Gien teaches writing a Root Certificate Authority certificate onto the token, [0011], [0031]. Gien teaches writing a unique private key that matches the unique

key certificate, [0189]. Gien teaches writing a software package capable of validating future keys and decrypting keys, [0122].

As per claim 2, Gien teaches wiping contents of the token after receiving, [0071].

As per claim 3, Gien teaches that the integrity of the hardware token must be ensured during all the manufacturing phases, [0069].

As per claims 9, and 10, Gien teaches loading keys and certificates onto the hardware token encrypted, [0190], [0193].

As per claim 11, Gien teaches using the keys from the certificates issued by the Root Certificate Authority to validate new keys, [0011],[0122].

As per claim 12, Gien teaches a subscriber for requesting a token, [0028].

As per claim 13, Gien teaches that the unique key encipherment certificate contains identification of the user, [0190].

As per claim 17, Gien teaches the hardware token is a smartcard, [0038].

As per claim 19, Gien teaches the processing center may be a certificate authority, [0011].

As per claim 21, Gien teaches the token is commercially available, [0008].

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2134

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gien in view of Deo US 5,721,781.

As per claim 4, Gein does not explicitly teach the smart card has a ROM.

Deo teaches a smartcard with a ROM capable of storing certificates, (Col 12 lines 6-15).

It would have been obvious to one of ordinary skill in the art to use the ROM of Deo with the smart card of Gein because the smart card needs memory in order to store data.

**Claims 6, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gien in view of Kiekhaefer US 6,290,137.**

As per claims 6, and 18 Gien does not teach use of the datacard 9000.

Keikhaefer teaches that the datacard 9000 for encoding a hardware token, (Col 4 lines 56-59). It would have been obvious to one of ordinary skill in the art to use a datacard 9000 because it has multiple sensors to use while encoding.

**Claims 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gien in view of Corella EP 117206A2**

As per claims 7, and 8 Gien teaches using Certification Authorities to issue certificates.

Gien does not teach storing certificates or public keys.

Corella teaches that a certificate authority maintains a database of public keys and associated certificates, (abstract).

Art Unit: 2134

It would have been obvious to one of ordinary skill in the art to use the database of Corella because the public keys are necessary for users to sign documents to send.

**Claims 14, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gien in view of Corella EP 117206A2 in view of Boyles US 6,738,901**

As per claims 14, 20, and 22, Gien as modified does not teach storing a set of public keys and certificates at the secure processing facility.

Corella teaches that a certificate authority maintains a database of public keys and associated certificates, (abstract).

It would have been obvious to one of ordinary skill in the art to use the database of Corella because the public keys are necessary for users to sign documents to send.

Boyles teaches storing a serial number associated with a smart card, (Col 7 lines 45-55).

It would have been obvious to one of ordinary skill in the art to combine the serial number of Boyle with the previous Gien-Corella system because it allows easy identification of accounts related to the user.

### ***Conclusion***

**4. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



Art Unit: 2134

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Brown whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jaques Louis Jaques can be reached on (571)272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher J. Brown

3/31/06

